

R E M A R K S

The last Office Action has been carefully considered.

It is noted that claims 17-20 and 23-24 are rejected under 35 U.S.C. 103(a) over the patent to Tanaka in view of the patent to Cash.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) over the patent to Tanaka in view of the patent to Heyler.

After carefully considering the Examiner's grounds for the rejection of the claims, applicant has amended claims 17, 21 and 23, the broadest independent claims, to more clearly define the present invention and to distinguish it from the prior art.

In particular, the independent claims now define that the particles used in the inventive device are formed as non electrically conductive particles and are treated with an electrically conductive substance.

Turning now to the references and particularly to the patent to Tanaka, it can be seen that Tanaka does not disclose any particles which are treated with an electrically conductive substance.

As for the patent to Cash, the patent to Cash discloses a system that enhances the conductivity of carbon dust by treating the carbon with specific molecular electrically conductive structure, such as fullerness or carbon nanotubes. Thus, Cash teaches basic electrically conductive particles which are additionally treated with electrically conductive structures.

The present invention is completely different from this concept. In the present invention the particles are not electrically conductive and they are treated with electrically conductive substance. This provides for a huge advantage, when compared with the patent to Cash. It is not necessary to produce electrically conductive particles, and instead those particles can be used which are non-conductive, which are easy to manufacture, and which are significantly less expensive than the conductive particles, thus the present invention significantly increases the range of the particles which can be used for the device.

The new features of the present invention as now defined in the independent claims are not disclosed in the references and also can not be derived from them as a matter of obviousness. In order to arrive at the applicant's invention from the references, the references have to be fundamentally modified by including into them the new features which are now defined in the independent claims, namely the non-conductive particles which are treated with an electrically conductive substance. It is known that

in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

As explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the solutions proposed in the prior art. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claims 17, 21 and 23 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, they depend on the independent claims, they share their presumably allowable features, and therefore they should be allowed as well.

Claims 25, 26 and 27 define additional features of the present invention. In particular, the non-conductive particles are composed of plastic, which is very inexpensive material and easy to manufacture. These claims should also be considered as patentably distinguishing over the art and should also be allowed.

In connection with the Examiner's comments in paragraph 1 of the Office Action that the original specification does not support the particles treated with an electrically conductive substance, the Examiner's attention is respectfully directed to page 6 of the specification, in particular the last paragraph, last five lines. It is clearly stated:

"On the other hand, the particles can be composed of a non electrically conductive material, for example plastic, and then treated with an electrically conductive substance for example with an aqueous emulsion of fullerenes or nanotubes."

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,

Ilya Zborovsky  
Agent for Applicant  
Reg. No. 28563

The required fee is submitted herewith. If the fee is missing or insufficient, it is respectfully requested to charge the fee to the account of the undersigned 26-0085.

Respectfully submitted,

  
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